

REMARKS

Claim 1-20 are currently pending in this application as amended. Claims 1-10 and 18-19 have been amended to overcome indefiniteness rejections. The Title of the Invention has been amended to correct an obvious typographical error. Claims 2-7 and 10 have been amended to refer back to amended claims 1 and 8, respectively. Claim 11 has been amended to correct a an obvious grammatical error. Further, claims 9 and 19 have been rewritten in independent form including all the limitations of their respective bases claims. According, no new matter has been added.

Rejections under 35 U.S.C. § 112

Claims 1-10 have been rejected under 35 U.S.C. § 112, second paragraph as being indefinite.

Claims 1-10 have been amended to recite a “blackjack game apparatus” instead of a “blackjack game.” Accordingly, the rejection of Claims 1-10 under 35 U.S.C. § 112 second paragraph has been overcome and should be withdrawn.

Claims 8-9 and 18-19 have been rejected as being indefinite because there is no recitation functionally relating a step of “placing a first wager” to a comparison to a player’s first hand with a dealer’s first hand and because there is no recitation functionally relating a step of “placing a second wager” to a comparison of the player’s second hand with the dealer’s second hand.

Claims 8-9 and 18-19 have been amended to include language functionally relating “placing a first wager” to a comparison of the player’s first hand with a dealer’s first hand and, as necessary, functionally relating “placing a second wager” to a comparison of the player’s second hand with the dealer’s second hand. Accordingly, the rejection of Claims 8-9 and 18-19 under 35 U.S.C. § 112, second paragraph has been overcome and should be withdrawn.

Rejections under 35 U.S.C. § 103(a)

Claims 1-8, 10-18 and 20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,615,888 (“Lofink et al.,” hereinafter, “Lofink”) in view of U.S. Patent Publication No. US2001\0040344 A1 (“Zahedi”).

Withdraw the rejections of Claims 1-8, 10-18 and 20 as respectfully requested for at least the following reasons.

Claim 1

Claim 1, recites, *inter alia*:

- (b) a set of rules for the card game, the rules including:
 - (i) removing all cards having a face value of ten from the one or more conventional decks of cards...
 - (v) paying each player having blackjack two times the respective player's wager, if the dealer does not have blackjack, blackjack being a condition when two cards add up to twenty-one.

Applicant respectfully submits that, for the reasons that follow, there is no suggestion in either Lofink or Zahedi to make the combination suggested by the Examiner and that making the modification suggested by the Examiner would impermissibly result in a change to the basic principle of operation of Lofink.

Lofink discloses a blackjack variation game (Spanish 21) using a forty-eight card deck including the Aces through the Nines and the Jacks, Queens and Kings, i.e., eliminating the four ten-point cards (i.e., on their face "10"). The elimination of the four ten-point cards shifts the odds of the game in favor of the house, so to make up for this difference and keep the game attractive to the players, Lofink discloses bonus payouts on the player's hand. The Examiner acknowledges that Lofink does not disclose "paying each player having blackjack two times the respective player's wager," as recited in claim 1.

The Examiner asserts that Zahedi discloses that it is known in the blackjack art to pay a player having blackjack at two times (two-to-one) the respective player's wager and points to paragraph [0029]. The Examiner asserts that it would have been obvious to modify Lofink's blackjack game by requiring that player's having blackjack be paid two times the respective player's wager.

The Applicant traverses the Examiner's argument that it would have been obvious to modify Lofink by Zahedi. While the games are each blackjack variation card games, the rules of the two games are divergent and conflicting.

Zahedi discloses a blackjack variation card game where the value of the jacks, queens and kings are changed from a value of ten to a value of two, three and four, respectively. (See paragraphs [0025]-[0027] and [0116]-[0118]). The game also includes other embodiments that pay two-to-one when buying insurance or for placing a bonus bet that are not relevant here. Because of the revaluation of the jacks, queens and kings, a player must get a ten-point card in combination with an Ace to get blackjack in the relevant embodiment of Zahedi. Because of the revaluation of the jack, queen and king, Zahedi provides a rule modification to shift the odds closer to conventional twenty-one which includes paying a player at two-to-one odds. Thus, in the game according to Zahedi, a player must get a ten-point card and an Ace to get blackjack and to be paid two-to-one odds.

It is well settled that when making a rejection under 35 U.S.C. § 103, the Examiner has the burden of establishing a *prima facie* case of obviousness. MPEP § 2142. As the Federal Circuit has pointed out, "it is impermissible to use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 5 USPQ.2d 1596, 1600 (Fed. Cir. 1988); see also MPEP § 2142. Moreover, something in the prior art *as a whole* must suggest the desirability, and thus the obviousness of the invention. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 5 USPQ.2d 1434, 1438 (Fed. Cir. 1988); see also MPEP § 2143.

The Examiner has failed to consider the two games as a whole, but instead has picked out features of Zahedi to cursorily attempt to modify Lofink. The rule changes from conventional blackjack are what determine the payouts and bonuses, not just getting blackjack. The rule changes in each are to compensate or shift the odds so that the games are still appealing to players, but making the suggested diverging rule changes would change the thrust of the Lofink game.

Lofink discloses blackjack variation game (Spanish 21) using a forty-eight card deck of cards eliminating the four ten-point cards. In Zahedi, the jack, king and queen are changed in value to 2, 3 and 4, respectively, leaving only the ten-point cards available to make a blackjack

combination during play. Therefore, in order to make a payout of two-to-one odds in Zahedi, a player's hand must include a ten-point card.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); MPEP § 2141.02. The proposed modification or combination of the prior art invention being modified cannot change the principle of operation of the reference. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); MPEP § 2143.01. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP § 2143.01

Even if, *arguendo*, there was sufficient motivation to include the two-to-one payout rule of Zahedi in the Spanish 21 game of Lofink, the modified Spanish 21 of Lofink game could never payout blackjack because Lofink discloses removing all of the ten-point cards and Zahedi discloses (in the relevant embodiment) only paying out two-to-one odds when a player gets a ten-point card and an Ace to get blackjack. Accordingly, the modification suggested by the Examiner would *impermissibly* materially change the principle of operation of the Lofink game, not just provide a "a game that's more exciting to play." Moreover, the suggested combination would *impermissibly* result in Lofink's game being unsuitable for its intended purpose (i.e., as a blackjack game) because a player could never achieve a blackjack payout, and the suggested combination would *impermissibly* change the basic principle under which Lofink was designed to operate.

Applicant therefore respectfully submits that claims 1-7 are not obvious under 35 U.S.C. § 103(a) in view of the attempted combination of Lofink and Zahedi because there is no suggestion in either reference as to the combination and because making the modification suggested by the Examiner would impermissibly result in a change to the basic principle of operation of Lofink. Accordingly, Applicant respectfully requests that the rejection of independent claim 1 and dependent claims 2-7 under 35 U.S.C. § 103(a) be withdrawn.

Claims 8-10, 11-18 and 20

Claims 8-10, 11-18 and 20 each contain rules and/or limitations similar to claim 1 above including removing all cards having a face value of ten from one or more conventional decks of cards and paying out two times a player's wager when the player has blackjack.

For all of the reasons set forth above with respect to claim 1, Applicant respectfully submits that claims 8-10, 11-18 and 20 are not obvious under 35 U.S.C. § 103(a) in view of the attempted combination of Lofink and Zahedi because there is no suggestion in either reference as to the combination suggested by the Examiner and because making the modification suggested by the Examiner would impermissibly result in a change to the basic principle of operation of Lofink. Accordingly, Applicant respectfully requests that the rejection of claims 8-10, 11-18 and 20 under 35 U.S.C. § 103(a) be withdrawn.

Allowable Subject Matter

The Examiner has stated that Claims 9 and 19 would be allowable if rewritten to overcome the rejections under 35 U.S.C. §112, second paragraph and to include all the limitations of the base claim and intervening claims.

As set forth above, Claims 8-9 and 18-19 have been amended to overcome the rejections under 35 U.S.C. §112, second paragraph. Further, Claims 9 and 19 have been rewritten in independent form to include all the limitations of Claims 8 and 18, respectively. Accordingly, Applicant respectfully requests that Claims 9 and 19 be allowed.

CONCLUSION

In the foregoing Amendment and Remarks, it is respectfully submitted that the present application, including claims 1-20, is in condition of allowance and such action is respectfully requested.

Respectfully submitted,

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